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Paper No. 11

In re Application of :  
Travis Nichols *et al* : DECISION ON PETITION  
Application No. 09/727,364 :  
Filed: November 29, 2000 :  
Attorney Docket No. 688-098 :

This is a decision on the petition filed on August 4, 2003 by which petitioners request withdrawal of the holding that this application stands abandoned for failure to file a proper and timely reply to the Office letter dated December 3, 2001. There is no fee for the petition.

The petition is dismissed as being untimely filed.

The record shows that on December 3, 2001, a requirement to elect a single species of the disclosed invention was mailed. On March 18, 2003, a Notice of Abandonment was mailed because petitioners had failed to file a reply to the election requirement. This petition was filed on August 4, 2003, with a 37 CFR 1.8(a) certificate of mailing dated July 31, 2003.

Under 37 CFR 1.181(f), a petition filed more than two months after the action complained of may be dismissed as being untimely. MPEP § 711.03(c) states, *inter alia*:

"37 CFR 1.181(f) provides that, *inter alia*, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f).

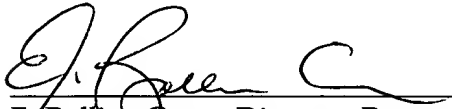
Rather than dismiss an untimely petition to withdraw the holding of abandonment under 37 CFR 1.181(f), the Office may treat an untimely petition to withdraw the holding of abandonment on its merits on the condition that, in any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period between the mail date of the notice of abandonment and the filing date of such petition to withdraw the holding of abandonment. See 37 CFR 1.183 (the Office may suspend or waive the requirements of 37 CFR 1.181(f), subject to such other requirements as may be imposed). The Office may treat an untimely petition to withdraw the holding of abandonment on its merits in a utility or plant application filed on or after June 8, 1995, on the condition that the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon that would extend beyond the date 20 years from the filing date of the application, or the earliest application to which the application specifically refers under 35 U.S.C. 120, 121, or 365(c). In either case, the terminal disclaimer must also apply to any patent granted on any application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c). Such a terminal disclaimer is not required under 37 CFR 1.137(d) because abandonment of an application is a per se failure to exercise due diligence, and as such, an applicant cannot obtain patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by abandonment of the application. Where a petition to withdraw the holding of abandonment is granted, the application is considered to never have been abandoned and, as such, the prosecution delay caused by the treatment of the application as abandoned is not considered a per se failure to exercise due diligence. Thus a terminal disclaimer is required to avoid granting patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by the treatment of the application as abandoned. " (Emphasis supplied.)

Because this petition was filed more than two months after the mailing of the Notice of Abandonment, this petition will not be treated on the merits absent a terminal disclaimer complying with the emphasized portions of the above quoted text. Petitioners may file a renewed petition, without fee, if the renewed petition is accompanied by a proper terminal disclaimer and the fee for the disclaimer.

As a courtesy to petitioners, it is noted that the instant petition was not accompanied by a copy of the reply alleged to have been filed on February 8, 2002. Absent a copy of that reply, the renewed petition can not be decided on its merits.

This application is being retained in Technology Center 3700 pending the filing of a renewed petition.

PETITION DISMISSED.



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